

54113.8004.US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

**Inventor:** Alison, Malcolm R. et al.

**Serial No.:** 09/769,204


**Filed:** January 24, 2001

**For: COMBINATIONS AND METHODS  
FOR PROMOTING IN VIVO LIVER  
CELL PROLIFERATION AND  
ENHANCING IN VIVO LIVER  
DIRECTED GENE TRANSDUCTION**

) **Group Art Unit:** 1636  
)  
)

) **Examiner:** Dan Sullivan  
)  
)

) I hereby certify that this correspondence (along with  
) any referred to as being attached or enclosed) is being  
) deposited this day, January 21, 2004, with the United  
) States Postal Service as first class mail in an envelope  
) addressed to MS AF, U.S. Patent and Trademark  
) Office, Commissioner for Patents, PO Box 1450,  
) Alexandria, VA 22313-1450.  
)

)   
) AMY SHIELDS  
)  
)

**AMENDMENT, RESPONSE AND TERMINAL DISCLAIMER**

Mail Stop AF  
Commissioner for Patents  
POB 1450  
Alexandria, VA 22313

Sir:

This paper responds to a final office action, mailed November 20, 2003. Thus, this response does not require any extension fees. The Action allowed Claims 51-65 and Applicants thank the Examiner for this allowance. As stated in the August 29, 2003 response, Applicants are willing to file a terminal disclaimer for Claims 26 and 27 solely in the interest of advancing prosecution. The terminal disclaimer is below. Finally, please delete Claims 66-68.

Applicants believe that this paper should address all issues and that remaining Claims 26, 27, and 51-65 should be in condition for allowance after the filing of this paper. The Examiner is asked to contact the Applicants' representative if anything further is required to receive the Notice of

Allowance.

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LA032340.030

Terminal Disclaimer for Claims 26 and 27

Amgen Inc. and Imperial College Innovations LTD., Assignees of the entire right, title and interest in the above-identified patent application by virtue of Assignments recorded in the U.S. Patent and Trademark Office at Reel 10507, Frame 0725, on December 20, 1999, and at Reel 11428, Frame 0960 on January 2, 2001, hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on presently pending Claims 26 and 27 of the instant application which would extend beyond the expiration date of the full statutory term defined in 35 USC §154 to §156 and §173, as presently shortened by any terminal disclaimer of US Pat No. 6,248,725.

In making this Disclaimer, Assignees do not concede or agree that any of the pending claims is obvious over any claim in the patents or application listed above. Rather, this Disclaimer is made only for expediency in the examination of the application.

The owners hereby agree that any patent so granted on present Claims 26 and 27 of the instant application shall be enforceable only for and during such period that it and the above-listed patent, US Pat No. 6,248,725, is commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantees, their successors or assigns.

In making the above disclaimer, the owners do not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 USC §154 to §156 and §173 of the above-listed patent, as presently shortened by any terminal disclaimer, in the event that said patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

**A. 1. Certification under 37 CFR §3.73(b)**

I, the undersigned, am empowered to act on behalf of the Assignees. The evidentiary documents referred to above have been reviewed by the undersigned and it is certified that to the best of my knowledge and belief, title is in the Assignees seeking to take action.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**B. 2. Fee Payment**

A check for \$110.00 (large entity) is enclosed covering the Terminal Disclaimer fee under 37 CFR 1.20(d)

Respectfully submitted,

PERKINS COIE LLP

Dated: January 21, 2004

By: 

Lauren Sliger

Reg. No. 51,086

Perkins Coie LLP  
Patent – LA  
P.O. Box 1208  
Seattle, WA 98111-1208  
Phone: (310) 788-9900  
Fax: (310) 788-3399



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In re the Application of:

Group Art Unit: 1636

Inventor: Alison, Malcolm R. et al.

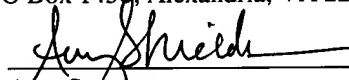
Examiner: Dan Sullivan

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FOR PROMOTING IN VIVO LIVER CELL  
PROLIFERATION AND ENHANCING IN  
VIVO LIVER DIRECTED GENE  
TRANSDUCTION**

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being deposited this day, January 21, 2004, with the United States Postal Service as first class mail in an envelope addressed to MS AF, U.S. Patent and Trademark Office, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

  
AMY SHIELDS

**Transmittal of Amendment and Response to Office Action**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

1. Transmitted herewith are the following:

- ☒ Amendment and Response to Office Action
- ☐ Petition for One-Month Extension of Time
- ☒ Terminal Disclaimer
- ☐ Sequence Listing printout, floppy diskette, matching declaration
- ☐ Information Disclosure Statement, Form PTO-1449 (modified), References.
- ☒ Check in the amount of \$110.00.

2. Entity Status

- ☐ Small Entity Status (37 C.F.R. § 1.9 and § 1.27) has been established by a previously submitted Small Entity Statement.

3. Conditional Petition for Extension of Time:

Applicant petitions for an Extension of Time, if necessary, for timely of this transmittal and enclosures.

4. Fee Calculation and Payment

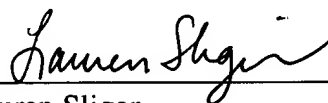
For:	(Col. 1) No. Filed	(Col. 2) No. Extra	Small Entity			Other Than a Small Entity	
			Rate	Fee	Rate	Fee	
Total Claims			x \$ 9 =	\$	or	x \$ 18 =	\$
Independent Claims			x \$ 43 =	\$	or	x \$ 86 =	\$
<input type="checkbox"/> Multiple Dependent Claim Presented			+ \$140 =	\$	or	+ \$280 =	\$
<input checked="" type="checkbox"/> Terminal Disclaimer Fee				\$			\$110.00
<input type="checkbox"/> Information Disclosure Statement Fee				\$			
*If the difference in Col. 1 is less than zero, enter "0" in Col. 2.			TOTAL	\$	or	TOTAL	\$110.00

A check in the amount of \$110.00 is enclosed.

5. Provisional Fee Authorization

Please charge any underpayment in fees for timely filing of this transmittal and enclosures or credit any overpayment of fees to Deposit Account No. 50-2586.

Respectfully submitted,  
Perkins Coie LLP



Lauren Sliger  
Registration No. 51,086

Date: January 21, 2004

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